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HM21/0526

EXAMINER	
STUCKER, J	
ART UNIT	PAPER NUMBER
1648	18

DATE MAILED: 05/26/98

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

### ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☒ is extended to run 6 months or continues to run \_\_\_\_\_ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due in accordance with 37 CFR 1.192(g).
- ☒ Applicant's response to the final rejection, filed 5/11/98 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
- c. ☐ They raise the issue of new matter. (See Note).
- d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

2. ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: \_\_\_\_\_  
Claims objected to: \_\_\_\_\_  
Claims rejected: 179 20-50

However;

- ☒ Applicant's response has overcome the following rejection(s): see attached action

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because see attached action

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

- ☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.
- ☐ Other

This Advisory Action is in response to the Response to Final Rejection filed 5/11/98. Claims 16, 18, and 19 are canceled. Claims 20-55 are added. Claims 17 and 20-55 are pending and under final rejection.

The abstract of the disclosure is objected to because it does not accurately describe the claimed invention. Correction is required. See MPEP § 608.01(b).

The rejection of claims 16-19 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention **is withdrawn** in view of the amendment to the claims.

The rejection of claims 17 and new claims 20-50 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention **is maintained**. Applicant's arguments have been fully considered but are not deemed to be persuasive. Applicant argues that because the specification teaches that the claimed peptides exhibit *in vitro*

viral inhibition and DP178 peptides inhibit HIV in HuPBMC-SCID mice that the claimed peptides are enabled for inhibiting HepB infection *in vivo*. This is not convincing as there is no correlation disclosed in the specification between the models relied upon and the scope of the invention as claimed. Applicant has not taught how to make and use the claimed invention in such a way so as to overcome the difficulties of moving from an *in vitro* model to a dynamic *in vivo* body. Therefore, the instant specification is not enabled for the scope of the claimed invention.

The instant invention appears to be free of the prior art.

No claims are allowed.

Papers related this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

The Group 1600 Fax numbers are: (703) 308-4242 and (703) 305-3014.

Unofficial communications may be faxed to: (703) 308-4426.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Stucker whose telephone number is (703) 308-4237. The examiner can normally be reached Monday to Thursday from 7:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Adams, Ph.D., can be reached on (703) 308-0570.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Jeffrey Stucker*